IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.: 08/902,005
Filing Date: 07/29/1997
Inventors: .... Butler, et al.
Appellant: .... Microsoft Corporation
Group Art Unit: 2623
Examiner: .... Tran, Hai V.
Confirmation No.: 9747
Attorney's Docket No.: MS1-119US
Title: PROVIDING ENHANCED CONTENT WITH BROADCAST VIDEO

REPLY BRIEF

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Sir:

In response to Examiner's Answer mailed April 19, 2006, in connection

with Appellant's Appeal Brief filed February 10, 2006, a Reply Brief is submitted.

Favorable consideration is respectfully requested.

The Office has withdrawn its rejections under 35 U.S.C. § 101 of claims 15 and 32.

Claims 1-43 and 45-50 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,929,849 to Kikinis in view of WO 96/10888 to Adams.

As to the rejection of claims 1-43 and 45-50 under § 103, the Office has simply restated verbatim its arguments from the Office Action issued on August 26, 2005. These arguments were thoroughly addressed in Applicant's Appeal Brief and in the interest of brevity, will not be repeated herein. The remainder of this Reply Brief will address the arguments presented in the Response to Arguments section of the Examiner's Answer (hereinafter "Answer").

Appellant submits that the requirements for establishing a *prima facie* case of obviousness have not all been met in the rejection from which this appeal has been made, or in the Answer to which this Reply responds.

With regard to establishing a *prima facie* case of obviousness, MPEP §2143 instructs as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Further, the mere fact that references *can* be combined or modified does not render a resultant combination obvious unless the prior art also suggests the *desirability* of the combination. In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1990)(citing In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984)).

Applicant maintains that the Office has failed to establish sufficient motivation to combine Kikinis and Adams. First, the Office argues that "Adams sets the background's color of the graphic object to a 'key color' in order to obtain a transparent background." Answer at page 19. However, as explained in Appellant's Appeal Brief, and particularly on pages 23-24, Adams fails to disclose this feature of Applicant's embodiment. In the interest of brevity, Applicant reasserts these arguments and will not repeat them herein.

In further rejecting Applicant's arguments, the Office argues that "Appellant fails to provide any facts/evidences why the explanation provided from the Examiner of modifying Kikinis Dynamic URL control routines with Adams' object oriented programming set *would not work or [be] feasible*, as combined...." Answer at page 19 (emphasis added). However, *workability* and *feasibility* are not the standards under which a proper § 103 motivation to combine references is established. As explained above, there must be some suggestion in the cited art as to the *desirability* of the combination. The motivation provided by the Office fails to appreciate this requirement and as such, fails to establish the desirability of combining Kikinis and Adams. Applicant again submits that the motivation provided by the Office to combine Kikinis and Adams is insufficient to support a rejection under § 103.

Claim 1

Claim 1 recites a method comprising the following steps [emphasis added]:

- transmitting a video stream;
- formatting supplemental data files in a graphical markup language, each supplemental data file having instructions for rendering a hyperlink overlay on the video stream, *wherein formatting comprises setting transparent areas of each hyperlink overlay to a key color*;
- transmitting the supplemental data files along with the video stream.

In rejecting this claim under § 103, the Office argues that "Kikinis clearly discloses supplemental data file (dynamic URL) having instructions for rendering a hyperlink overlay on the video stream that was transmitted in the transmitting step...." Answer at page 20. The Office repeats its previous argument that Kikinis discloses this feature at figure 3A. However, as discussed in Applicant's Appeal Brief, there appears to be nothing in this section or elsewhere in Kikinis that discloses or suggests supplemental files having instructions for rendering a hyperlink overlay on a video stream wherein the supplemental data files are *transmitted along with the video stream*. The section of Kikinis cited by the Office fails to address this particular feature.

Further, the Office maintains that the dynamic URL of Kikinis is analogous to Applicant's claimed supplemental data files having instructions for rendering a hyperlink overlay on the video stream. The Office argues that a "dynamic URL is a control routine...which is notoriously known in the computer art to be files with CGI extension or Scripts with coded syntax or instruction[s]

of programming language…that could be processed by Web browser." <u>Answer</u> at page 21, first paragraph. The Office further argues that "Kikinis clearly shows…a data stream…is received bearing entity data and dynamic URL in a data region…separate from image frame data…." <u>Id.</u> at second paragraph. However, these arguments still fail to fully address this feature of the present claim, and particularly that of ***instructions for rendering a hyperlink overlay on the data stream***. This argument is addressed in Applicant's Appeal Brief and in the interest of brevity will not be restated herein.

Still further, the Office argues that Adams' "chrominance key" is analogous to Applicant's "key color." <u>Answer</u> at page 22. However, as acknowledged by the Office, Adams discloses that "[f]or other embodiments, the associated data stream is carried via a chrominance key…." <u>Adams</u> at page 20, lines 15-16. The Office further argues that "in order to obtain a transparent Background of an object, the background color must be set to a 'key color' or chrominance key!" <u>Answer</u> at page 22 (emphasis omitted). However, Adams' ability to "obtain a transparent background of an object" fails to disclose or suggest this feature of claim 1. As thoroughly explained in Applicant's Appeal Brief, Adams' chrominance key is simply not equivalent to Applicant's claimed key color.

Claim 2

Claim 2 recites a method as recited in claim 1 wherein the formatting step comprises formatting the supplemental data files in HTML.

The Office again argues that the ***Dynamic URL*** of Kikinis is analogous to Applicant's ***supplemental data files*** having instructions for rendering a hyperlink overlay on the video stream. Accordingly, Applicant reasserts that this argument fails and that these are not analogous structures. Further, as explained in Applicant's Appeal Brief, "while the web page [of Kikinis] would certainly contain HTML, there is nothing in Kikinis that indicates that the HTML has instructions for rendering a hyperlink overlay (as recited in this claim) on the video stream that is recited to be transmitted." Appeal Brief at page 25. The subject matter of this claim is simply missing from the cited references.

Claim 3

Claim 3 recites a method as recited in claim 1 and further comprising a step of transmitting timing specifications with the supplemental data files indicating times for displaying the hyperlink overlays.

The Office again argues that Kikinis' Dynamic URL is analogous to Applicant's ***supplemental data files*** having instructions for rendering a hyperlink overlay on the video stream. Applicant reasserts that this argument is misguided and that these are not analogous structures.

Further, the Office argues that

> Since Kikinis is silent about the step of transmitting timing specifications with the supplemental data files, as claimed, it is unclear how Appellant concludes that Kikinis has already taken into account

any synchronization issues in its specific solution without providing any clear explanation or showing facts that would not suffer from any synchronization problems." <u>Answer</u> at page 25.

First, Applicant notes that Kikinis is indeed "silent about the step of transmitting timing specifications with the supplemental data files" since, as explained above, Kikinis fails to disclose or suggest supplemental data files. Further, it is illogical for the Office to argue that the failure to explain how Kikinis does not suffer from synchronization problems results in an assumption that Kikinis does indeed suffer from synchronization problems. The Office has imputed this deficiency to Kikinis without a sound basis to do so. Finally, Kikinis' URL frames are provided adjacent to the images with which they are associated, thus anticipating any problem with synchronization. <u>See Appeal Brief</u> at pages 26-27.

<u>Claim 5</u>

Claim 5 recites a method as recited in claim 1 and further comprising the following additional steps:

- receiving the video stream and accompanying supplemental data files;
- displaying the hyperlink overlays in conjunction with the video stream.

With respect to this claim, the Office again asserts that Kikinis teaches Applicant's supplemental data files. Accordingly, as explained above and in

Applicant's Appeal Brief, Applicant submits that Kikinis neither discloses nor suggests this feature.

Further, the Office argues that figure 4 of Adams discloses a "video stream with supplemental data files." Answer at page 26. However, the "associated data" disclosed in this figure of Adams is not the supplemental data files having instructions for rendering a hyperlink overlay on the video stream as claimed in this claim and claim 1 from which it depends. This feature is simply missing from Adams.

Claim 7

Claim 7 recites a method as recited in claim 5, wherein:

- the displaying step comprises displaying the video stream only in the areas of the hyperlink overlays that are set to a key color.

First, the Office argues that "Appellant further keeps attacking references individually where the rejections are based on combinations of references." Answer at page 26. However, since the Office is relying on individual references to teach specific features of Applicant's claims, it is entirely appropriate for Applicant to attack the references individually. Under § 103, if the prior art reference (or references when combined) fail to teach or suggest all the claim limitations, then the Office has failed to establish a *prima facie* case of obviousness.

Further, the Office argues that Adams discloses a key color as claimed by Applicant. However, as explained above and in the Appeal Brief, Adams fails to disclose or suggest this feature. The section of Adams cited by the Office (page

23, line 10, through page 24, line 10) in no way discloses or suggests the concept of a key color.

Claims 8-10

With respect to these claims, the Office again argues that Adams discloses a key color as claimed by Applicant. The Office cites to figure 2 of Adams, element 56, as teaching this feature. However, Adams explains that "graphics display subsystem 56 performs graphics rendering functions and includes a frame buffer and associated circuitry to drive the display device...." Adams at page 15, lines 9-11. Nowhere in this feature of elsewhere does Adams disclose or suggest a key color as claimed by Applicant.
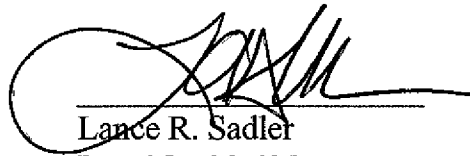
As to the remainder of Applicant's claims, the Office simply asserts that "Kikinis in view of Adams discloses supplemental data files; key colors and the references disclose color keying hardware, as previously discussed." Answer at page 28. However, as explained above and in the Appeal Brief, the cited references fail to disclose these features. Accordingly, Applicant submits that the Office has failed to establish a *prima facie* case of obviousness with respect to these claims and these claims are allowable.

Conclusion

For at least the reasons provided above, it is respectfully submitted that the rejections set forth in the Office Action of August 26, 2005, in connection with the subject application should be reversed. Favorable consideration of this Reply Brief is respectfully requested.

Respectfully submitted,

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